

REMARKS

Claims 1-24, 55-61 and 63 are in the present application.

Applicant respectfully thanks the Examiner for the telephonic interview conducted on March 01, 2004. Claims 1, 55 and 63 were discussed. Possible amendments limiting claims 1, 55 and 63 to "about 37 degrees" were discussed. The undersigned pointed to the cited art and Applicant's previous submission which showed a teaching away from "about 37 degrees." The Examiner wished to see data showing unexpected results. No agreement with respect to the claims was reached.

Claim Rejections - 35 U.S.C. § 103 (a)

Claims 1-5, 7-19, 24, 55-57 and 59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Newton et al (U.S. Patent No. 5,595,890) in view of Walker et al (Nucleic Acids Research, 1992, 20(7):1691-1696) and Krausa et al. (Human Immunology, 1995, 44:35-42).

An obviousness rejection may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). In the present case, the cited art teaches away from currently amended independent claims 1, 55 and 63, which recite "under isothermal conditions at about 37 degrees Celsius." Newton et al. and Walker teach away from presently claimed use of isothermal conditions at low temperatures, because such conditions are likely to lead to the generation of artefactual products arising from extension of the detector primer even in the presence of a mismatched diagnostic nucleotide (for more detailed argument, please see the Request for Continued Examination submitted January 29, 2003). Accordingly, one of ordinary skill in the art would not have been motivated to combine the methods of Newton et al. and Walker et al. because the expectation of success resulting from this combination would have been low, and Krausa et al. adds no further relevant teachings. Indeed, the unexpected success of the claimed invention is set forth in Examples 1 and 2.

Further, because the prior art teaches away from a method "under isothermal conditions at about 37 degrees Celsius," the present claims do not represent an optimization of experimental conditions. One of ordinary skill in the art would have been motivated to increase, not decrease the temperature.

Accordingly, Applicants respectfully submit that the present claims are not obvious to one of ordinary skill in the art.

Applicants respectfully submit that Applicant's argument regarding isothermal conditions at low temperatures are commensurate with the scope of the present claims.

Claims 6 and 58 were rejected under 35 U.S.C §103(a) as being obvious over Newton et al. in view of Walker et al. and further in view of Reynolds (U.S. Patent No. 5,763,14) and Mullis et al. (U.S. Patent NO. 4,683,195).

Newton et al. and Walker et al. do not teach or suggest the claimed invention. Applicants respectfully submit that Reynolds and Mullis et al. are secondary references which add no further teachings which would enable one of ordinary skill in the art to achieve the claimed invention.

Claims 20, 21, 60 and 61 were rejected under 35 U.S.C §103(a) as being obvious over Newton et al. in view of Walker and further in view of Chen et al (Nucleic Acids Research, 1997, 25(2): 347-353).

For the same reasons provided above, Applicants respectfully submit that the additional teachings of the secondary reference Chen et al. do not enable one of ordinary skill in the art to achieve the claimed invention.

Claims 22 and 23 were rejected under 35 U.S.C §103(a) as being obvious over Newton et al. in view of Walker and further in view of Thomas et al. (U.S. Patent No. 6,025,130).

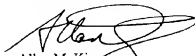
For the same reasons provided above, Applicants respectfully submit that the additional teachings of the secondary reference Thomas et al. would not enable one of ordinary skill in the art to achieve the claimed invention.

Accordingly, Applicants respectfully request withdrawal of the present rejections under Section 103.

Conclusion

The claims of the present application are believed to be in condition for allowance, and early notice thereof is respectfully requested.

Respectfully submitted,



Allan M. Kiang
Attorney for Applicants
Registration No. 42,275

Becton Dickinson and Company
1 Becton Drive
Franklin Lakes, New Jersey 07416
(201) 847-7111

#75250